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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,563	01/21/2000	Stuart Kent Card	07447.0026-00000	4607

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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 12/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/488,563

Applicant(s)

CARD ET AL.

Examiner

Doug Hutton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The attempt to incorporate subject matter into this application by reference to the numerous publications listed from Page 18, Line 12 to Page 19, Line 8 is improper because "essential material" may not be incorporated by reference to non-patent publications. The statistical analyses disclosed in these publications are "essential material" because they are necessary to describe the claimed invention. See MPEP § 608.01(p).

The attempt to incorporate subject matter into this application by reference to the numerous publications listed on Page 27, Lines 10-13 is improper because "essential material" may not be incorporated by reference to non-patent publications. The information visualization spreadsheets disclosed in these publications are "essential material" because they are necessary to describe the claimed invention. See MPEP § 608.01(p).

The attempt to incorporate subject matter into this application by reference to the numerous publications listed on Page 27, Lines 15-18 is improper because "essential material" may not be incorporated by reference to non-patent publications. The perspective walls disclosed in these publications are "essential material" because they are necessary to describe the claimed invention. See MPEP § 608.01(p).

The disclosure is objected to because of the following informalities:

- the term “selecting” on Page 28, Line 21 should be amended to — selected — because it appears to be a typographic error;
- the term “provided” on Page 30, Line 7 should be amended to — provide — because it appears to be a typographic error; and
- the term “discussed” on Page 34, Line 6 should be amended to — discussion — because it appears to be a typographic error;

Appropriate correction is required.

Claim Objections

Claims 1, 9 and 18 are objected to because of the following informalities:

- the phrase “the steps of” should be inserted at the end of Claim 1, Line 2 because the claim is for a method; Claims 9 and 18 have the same problem.

Claims 2, 11 and 19 are objected to because of the following informalities:

- the term “statistical” in Claim 2, Line 2 should be amended to — statistically — because it appears to be a typographic error; Claims 11 and 19 have the same problem.

Claim 10 is objected to because of the following informalities:

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- insert the term “storage” in Line 1 between the terms “a” and “medium” because that is how the element is later identified (see Lines 9-10);
- the phrase “computer-readable” should be inserted in Line 3 between the terms “a” and “program”, and the phrase “that cause the apparatus” should be inserted in Line 6 between the terms “instructions” and “to” in order to clearly indicate that the apparatus is a computer system that has a utility; and
- the term “gathers” in Line 6 should be amended to — gather — because it appears to be a typographic error.

Claim 23 is objected to because of the following informalities:

- the term “comprising” in Line 3 should be amended to — said method comprising the steps of — because the claim is for a method that is embodied on computer software.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 10-13 and 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Goffman, U.S. Patent No. 5,594,897.

Claim 1:

Goffman discloses a method of producing a storage medium that provides information regarding a source material (Column 7, Line 3 through Column 8, Line 2 – the “source material” is the “starter” journal), comprising the steps of:

- gathering features of the source material (Column 7, Line 3 through Column 8, Line 2 – the “features” are the citations of “other” journals in the starter journal);
- accessing secondary materials related to the features (Column 7, Line 3 through Column 8, Line 2 – the “secondary materials” are the “other” journals);
- gathering features of the secondary materials (Column 7, Line 3 through Column 8, Line 2 – the “features” are the citations of additional journals in the “other” journals);
- determining attributes of the gathered materials (Column 7, Line 3 through Column 8, Line 2 – the “attribute” of each “gathered material” is its “relevance value”);
- analyzing the attributes based on a predetermined characteristic (Column 7, Line 3 through Column 8, Line 2 – the “predetermined characteristic” is the “threshold relevance value”); and

- recording information regarding the source material and the secondary materials based on the analysis (see Figures 4 and 5; Column 7, Line 3 through Column 8, Line 2 – the “information regarding the source material” is recorded in the “trees”).

Claim 2:

Goffman discloses the method of Claim 1, wherein the determining step includes statistically analyzing the features of the source material and the features of the secondary materials (Column 7, Line 3 through Column 8, Line 2 – the “features” are “statistically analyzed” in that a relevance value is determined for each “other” journal).

Claim 3:

Goffman discloses the method of Claim 1, wherein the determining step includes incrementing an iteration number (see Figure 1B-1; Column 14, Line 48 through Column 15, Line 8 – an “iteration number” is incremented in that the process is repeated until a certain number of journals are collected).

Claim 4:

Goffman discloses the method of Claim 1, wherein the recording step includes recording the source material, features of the source material, the secondary material, and features of the secondary materials (see Table 2 in Column 16 – all of the specifics are recorded as illustrated).

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Claims 10-13:

These claims are for a computer system that performs the method specified in Claims 1-4. Thus, Goffman discloses every element of Claims 10-13.

Claims 18-21 and 23:

These claims are for computer software that performs the method specified in Claims 1-4. Thus, Goffman discloses every element of Claims 18-21 and 23.

Claim 22:

Goffman discloses the medium of Claim 18, wherein the storage medium is the Internet (Column 14, Line 34 through Column 15, Line 8).

Claims 5-9, 14-17 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Lawrence et al., U.S. Patent No. 6,289,342.

Claim 5:

Lawrence discloses a method of providing an interface for graphically displaying information, comprising the steps of:

- displaying information regarding a source material and a set of secondary materials (see Figure 5 – the “source material” is at the top, and the “secondary materials” are at the bottom);

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- determining a selection of information based on a user input (Column 11, Lines 15-37 – the “selection of information” is “determined” “based on a user input” in that the user clicks on “Details” for one of the citations);
- analyzing the source material, the set of secondary materials, and the selection of information (the source material, the secondary materials and the selection of information are all “analyzed” during the querying and displaying processes); and
- updating the display of information regarding the source material and the set of secondary materials based on the analysis (see Figure 6 – once a user clicks on “Details” for one of the citations, the citation indexing system “updates the display” by presenting the cited document in the context of the citation).

Claim 6:

Lawrence discloses the method according to Claim 5, wherein the updating step highlights a particular set of the secondary materials, so as to bring the particular set of the secondary materials to the attention of the user (the citation chosen by the user is a “particular set of the secondary materials,” and it is “highlighted” and brought “to the attention of the user” in that the citation is displayed with the cited document in the context of the citation).

Claim 7:

Lawrence discloses the method according to Claim 5, wherein the displaying step includes displaying a representation of objects of the source material in a first area

and displaying a representation of objects of the secondary materials in a second area (see Figure 5 – the “representation of objects” of the source material is at the top, and the “representation of objects” of the secondary materials is at the bottom).

Claim 8:

Lawrence discloses the method according to Claim 7, wherein the updating step rearranges the locations of the representations of the objects of the secondary materials (the locations of the “representation of objects” of the secondary materials are “rearranged” in that, when the user clicks on “Details” for one of the citations, the citation indexing system “updates the display” by presenting the cited document in the context of the citation).

Claim 9:

Lawrence discloses the method according to Claim 7, further comprising the step of:

- linking the first area and the second area so that a user input to either area will effect the display in the other area (the first area and the second area are both “linked” in that the user can click on hypertext in either area; once the user clicks on the hypertext in either area, the display in the other area is “effected” in that a new display screen is presented to the user).

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Claims 14-17:

These claims are for a graphical user interface that performs the method specified in Claims 5-9. Thus, Lawrence discloses every element of Claims 14-17.

Claim 24:

This claim is for computer software that performs the method specified in Claims 5-9. Thus, Lawrence discloses every element of Claim 24.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Pirolli et al., U.S. Patent No. 5,835,905; Tada et al., U.S. Patent No. 5,832,476; Graham, U.S. Patent No. 6,647,534; Hill et al., U.S. Patent No. 6,256,648; Holt et al., U.S. Patent No. 5,761,497; and Ainsbury et al., U.S. Patent No. 6,078,924.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (703) 305-1701. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

WDH

November 21, 2003



**HEATHER HERNDON
SUPERVISORY PATENT EXAMINER
TECH CENTER 2100**